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Remarks

Reconsideration is requested of the application in which claims 1, 4, 6, 7, 16, 21, and 25-26 will be pending after enter of the above amendments.

Claim Objections - 35 U.S.C. §112:

Claim 16 was objected to based on lack of antecedent basis with regard to "the first and second networks". This claim is amended to render moot this objection.

Claim Rejections - 35 U.S.C. §103:

Claims 1, 4, 16, 21 and 24 were rejected under 35 U.S.C. §103 in view of Mills (U.S. Patent No. 5,890,063) and Ahrens (U.S. Patent No. 5,848,144). Applicants respectfully traverse the rejections as explained below.

Applicants respectfully submit that the applied references, with or without combination, assuming, *arguendo*, that the combination of the applied references is proper, do not teach or suggest one or more elements of the claimed invention, as further discussed below. For explanatory purposes, applicants discuss herein one or more differences between the applied references and the claimed invention with reference to one or more parts of the applied references. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of the applied references correspond to the claimed invention.

Claim 1 is directed to a method of migrating subscribers from a first network to a second network. At least one connection is transferred from at least one other network from a GMSC1 to a GMSC2. An HLR in the second network is updated with routing information about subscribers now served by the second network. All call requests are sent from the at least one other network for subscriber served by one of the first and second networks directly to the GMSC2. The second network employs a different network technology than the first network. The GMSC2 queries the HLR (of the second network) for routing information for a destination subscriber upon receiving a call request without requiring routing information obtained by a

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prior query to an HLR of the first network. If routing information for the destination subscriber is available from the HLR in response to the query, the GMSC2 routes the call to the second network. If no routing information for the destination subscriber is available on the HLR in response to the query, the GMSC2 routes the call to the first network.

The method of claim 1 differs substantially from and is not obvious in view of Mills, or the combination of Mills in view of Ahearn. Figure 9 of Mills illustrates its method for routing calls. Where the mobile station of Mills is served by a different network with a corresponding different (second) HLR and gateway, and a call to the mobile is received, it is first sent to the HLR of the first network and then to the gateway of the first network. See Mills, column 8, lines 24-60. This is contrary to the requirements of claim 1 where calls for such a mobile are directly sent to GMSC2, i.e. the gateway of the second network, without having been previously sent to the gateway of the first network and without having to obtain routing information from the HLR of the first network. Not only does Mills not teach this requirement, it teaches away from it. Ahearn was not cited for such a teaching. Thus, neither reference considered individually or in combination renders claim 1 obvious.

In the Office Action it was mentioned with respect to Ahearn that after a midpoint of migrating subscribers, all traffic is routed to the post-cut switch. This was alleged to read on the portion of claim 1 in which all call requests are directed to the second network. In accordance with claim 1, if routing information for the destination subscriber is available from the HLR (second network) in response to the query, the GMSC2 routes the call to the second network. If no routing information for the destination subscriber is available from the HLR (second network) in response to the query, the GMSC2 routes the call to the first network. In Ahearn (column 7, lines 24-28) the midpoint routing change is explained. That is, once a transition midpoint is identified, the end office codes previously associated with the precut switch are shifted to the post-cut switch. This is not equivalent to the requirement of claim 1.

In Ahearn, the end office code positively identifies the specific switch to which a call will be terminated in order to reach a designated subscriber served by that switch. Even during the midpoint of the cut over process, the post-cut switch will know whether the subscriber associated

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with the dialed directory number is supported by the post-cut switch or the pre-cut switch. That is, the true routing information as to the destination of the dialed subscriber's line will always be known. In accordance with claim 1, "if no routing information for the destination subscriber is available from the HLR in response to the query, the GMSC2 routes the call to the first network". This will never be the case in Ahern since the line termination destination of the subscriber is always known. In fact, the very purpose of a switch cut over is to migrate the line termination of the subscriber from one switch to another. Hence, the line termination will always be known. Thus, Ahern is not equivalent to the limitation in accordance with claim 1. Therefore, neither of the applied references teaches this required limitation.

In accordance with claim 6, a message is sent to the another HLR of the first network notifying the first network that the subscriber associated with the call is actively engaged in a call on the second network when the GMSC2 routes the call to the second network. Claim 6 was rejected under 35 U.S.C. 103 based on Mills, Ahern and in further view of Houde (U.S. Patent No. 5, 978, 678). In the Office Action Houde was alleged to disclose the system in which a roaming mobile receives an incoming call, and a roaming network sends to the HLR of the home network a temporary local directory number. Assuming arguendo that Houde provides such a teaching, such a teaching would still not meet the required limitation. That is, merely sending a temporary local directory number would merely communicate that the roaming mobile could be called at the temporary local directory number. The mere receipt of a temporary local directory number would not imply that the roaming mobile was actively engaged in a currently ongoing call. Thus, even considering the alleged teaching, it is insufficient to meet the limitation specified in claim 6 and hence this claim is not rendered obvious based on the applied art.

Apparatus claim 16 is believed to be allowable for similar reasons discussed above with regard to claim 1.

Claims 7, 25 and 26 were rejected under 35 U.S.C. 103 based on Mills, Ahern, and further in view of what was well known at the time of the invention (MPEP 2144.03). In the Office Action, the examiner took official notice that a TDMA network was well known in the art at the time of the invention. Assuming arguendo this is true, such knowledge per se would not

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render the required combination of a TDMA network and a GSM network obvious in view of the substantial differences in technologies and interface problems that would be encountered in trying to combine two such different systems.

As provided in the MPEP:

"It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a *prima facie* case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.")."

It is believed to be clear that one of ordinary skill the art would not find the combination and interworking of a TDMA and GSM network to be "capable of instant and unquestionable demonstration as being well known". Hence, the relied upon combination to find obviousness is not permissible.

Applicant specifically addressed and traversed the taking of official notice in applicant's previous communication. In accordance with the MPEP:

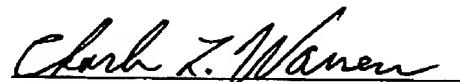
"If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697"

Since the examiner has not provided documentary evidence as required by the MPEP based on applicant's specific traversal of the basis for the taking of official notice, the current rejection of claims 7, 25 and 26 fails to meet the requirements on the MPEP and hence fails to state a valid *prima facie* rejection. Withdrawal of the rejections of these claims is sought.

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If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney at 630-584-9206.

Respectfully submitted,



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